

In the Drawings

Please add new drawings Figures 3 and 4 which are attached hereto.

REMARKS

The Examiner has objected to the drawings under 37 CFR 1.83(a). The Examiner has stated that a "program diagram of the method of claims 1-7 and 15-19" must be shown or the features cancelled from the claims. In response to this rejection, Applicants have submitted new drawings Figures 3 and 4. Figure 3 is a flow diagram that contains the method steps as described in claims 1, 2, 4 and 5. Claims 3, 6 and 7 have been cancelled. Figure 4 is a flow diagram that contains the method steps as described in claim 15.

The Examiner has rejected claims 1-14 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response to this rejection, Applicants have amended claims 1, 15 and 20 to cure the typographical error in question. Independent claim 8 has been cancelled.

Applicants have cancelled claims 3, 6-8, 10, 13-14 and 21-24 thereby rendering moot any rejections directed to these claims.

The Examiner has rejected claims 1-6 and 8-13 under 35 USC 102(b) as being anticipated by Mills Bonus. Applicants have cancelled claims 3, 6-8 and 13. Applicants submit that Mills Bonus does not anticipate amended claims 1, 2, 4, 5, 9 and 11-12. According to the Federal Circuit, "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." W.L. Gore & Assocs. V. Garlock, Inc. 220 USPQ 303, 313 (Fed. Cir. 1983). Furthermore, it is not enough that the reference disclose all of the claimed elements in isolation. Rather, as stated by the Federal Circuit, the prior art reference must disclose each element of the claimed

invention arranged as in the claim. Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984). The exclusion of a claimed element from a prior art reference is enough to negate anticipation. Connell v. Sears, Roebuck & Co., 220 U.S. P.Q. 193,198 (Fed. Cir. 1983). In order for anticipation to exist, the Examiner must clearly show that the missing element not described in the cited reference is necessarily present in the apparatus described in the cited reference. Continental Can Co. USA v. Monsanto Co., 20 USPQ2d 1746, 1749-50 (Fed. Cir. 1991). Functional limitations in a claim cannot be ignored when determining whether anticipation exists. (see In re Land, 151 USPQ 621 (C.C.P.A. 1966). A careful review of Mills Bonus reveals that the letters of the word "BONUS" appear only on the first reel of the Mills gaming machine and that the letters must appear at the pay-line in the correct sequence in order to spell the word "BONUS". On the other hand, in the method of amended claim 1, symbols can randomly appear anywhere in the game display. This is also explained in the instant specification on page 8, lines 15-18: "When reels 18 stop spinning and particular symbols appear anywhere in game display 12 of gaming machine 10, display 14 activates symbols 20 that match the symbols appearing in display 12". The Examiner is also referred to page 12, lines 6-10 of the instant specification. Thus, no matter where the symbols appear in the game display, identical symbols in the active-paytable will be activated. As a result, the identical symbols in the active-pay-table are activated in a random manner. Mills Bonus does not disclose this feature and therefore, cannot anticipate amended claims 1, 2, 4, 5, 9 and 11-12.

The Examiner has rejected claims 7 and 14 under 35 USC 103 (a) as being unpatentable over Mills Bonus in view of Kaminkow U.S. Patent No. 6,695,696.

Applicants have cancelled claims 7 and 14 thereby rendering moot this rejection.

However, Applicants do not agree with the Examiner's conclusion with respect to the Examiner's combination of Mills Bonus and Kaminkow.

The Examiner has rejected claims 15, 19-20 and 24 under 35 USC 103(a) as being unpatentable over Brossard et al. U.S. 6,364,767 in view of Mills Bonus. Applicants have cancelled claim 24. Applicants have amended claim 15 to recite "playing the gaming machine so that symbols randomly appear anywhere in the game display in accordance with normal play". Applicants have amended claim 20 to recite "a game display for randomly displaying symbols resulting from normal play of the gaming machine, the symbols appearing anywhere on the game display". As a result, identical symbols in the active pay-table are activated no matter where the corresponding identical symbols in the game display are located. As a result, the identical symbols in the active-pay-table are activated in a random manner. It has already been established in the foregoing remarks that Mills Bonus does not disclose this feature. Furthermore, Brossard does not disclose this feature. Brossard discloses an electronic game terminal that allows a user to select one component from among a pluralities, one of which being entertainment (e.g. songs, videos). Brossard does not disclose, teach or suggest the particular combination of elements in claims 15 and 20. This obviousness rejection is not proper. An invention cannot be found obvious unless there was some explicit teaching or suggestion in the art to motivate one of ordinary skill to combine elements so as to create the same invention. (emphasis added). Winner International Royalty Corp. v. Wang, No. 96-2107, 48 USPQ2d 1139, 1140 (D.C. D.C. 1998). "The showing of combinability, in whatever form, must nevertheless be clear and particular." (emphasis added). Winner

International Royalty Corp. v. Wang, 53 U.S.P.Q. 2d 1580 (Fed. Cir. 2000).

Furthermore, it is impermissible to attempt to use claims as a frame, and use individual parts of prior art as a mosaic in an attempt to recreate a facsimile of the invention.

Interconnect Planning Corp. v. Feil, 227 U.S.P.Q. 2d 543, 551 (Fed. Cir. 1985). There is no explicit teaching or suggestion in Mills Bonus and Brossard that would motivate one of ordinary skill in the art to combine the teachings of these references to arrive at the inventions as claimed in amended claims 15 and 20. Mills Bonus and Brossard clearly do not disclose the claimed features of "symbols randomly appearing anywhere in the game display and in response, activating identical symbols on the active pay-table". Therefore, Applicants submit that the combination of Mills Bonus and Brossard does not render obvious amended claims 15 and 20.

The Examiner has rejected claims 16-18 and 21-23 under 35 USC 103 (a) as being unpatentable over Brossard in view of Mills Bonus and further in view of Meekins et al. U.S. Patent No. 6,685,563. Claims 21-23 have been cancelled. Claims 16 and 18 depend from independent claim 15. Since it has been shown that claim 15 is patentable over the cited references, Applicants submit that claims 16 and 18 are patentable as well.

Similarly, claims 2, 4, 5 and 9 depend directly or indirectly from claim 1. Since it has been shown by the foregoing remarks that amended claim 1 is patentable over the cited references, Applicants submit that claims 2, 4, 5 and 9 are patentable as well.

Applicants have added new claim 25. Claim 25 contains the same distinguishing elements and limitations that have been incorporated into claims 1, 15 and 20. For the foregoing reasons set forth with respect to amended claims 1, 15 and 20, Applicants submit that claim 25 is patentable over the cited references as well.

Claims 11 and 12 depend either directly or indirectly from new claim 25. Since it has been shown by the foregoing remarks that amended claim 25 is patentable over the cited references, Applicants submit that claims 11 and 12 are patentable as well.

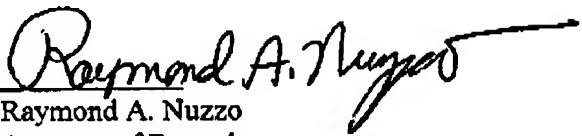
There is no fee due for adding claim 25.

It is submitted in view of these amendments and remarks that all grounds for rejection have been removed. Reconsideration and allowance of this application are therefore earnestly solicited. Applicants encourage the Examiner to call the undersigned attorney if there is any matter or issue that can be resolved through a telephone conference.

A Petition for Extension of Time for three (3) months is enclosed herewith along with the corresponding fee.

Respectfully submitted,

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By:   
Raymond A. Nuzzo  
Attorney of Record  
Reg. No. 37199

Law Offices of Raymond A. Nuzzo, LLC  
579 Thompson Avenue  
East Haven, CT 06512

Tel: 203-467-7895  
Fax: 203-467-7233